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OFFICE OF PETITIONS

In re Patent No. 7,531,174	:	
Sanicola-Nadel et al.	:	DECISION ON REQUEST FOR
Issue Date: May 12, 2009	:	RECONSIDERATION OF
Application No. 10/693,538	:	PATENT TERM ADJUSTMENT
Filed: October 23, 2003	:	AND NOTICE OF INTENT TO
Docket No. BGG-A117CNRCE2	:	ISSUE A CERTIFICATE OF CORRECTION

This is in response to the RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION, filed August 26, 2009, which is properly treated as a petition under 37 CFR 1.705(d). Patentees request that the determination of patent term adjustment be corrected from two hundred ten (210) days to five hundred thirty-one (531) days, or in the alternative, two hundred thirty-two (232) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED to the extent indicated herein.

Patentees are given **THIRTY (30) DAYS** or **ONE (1) MONTH**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **two hundred thirty-three (233) days**.

BACKGROUND

On May 12, 2009, the application matured into U.S. Patent No. 7,531,174, with a revised patent term adjustment of 233 days

(404 days of Office delay - 171 days of applicant delay). On July 10, 2009, patentees timely submitted a request for reconsideration of patent term adjustment within two months of the issue date of the patent. On July 27, 2009, the Office mailed a decision on the request stating that the patent term adjustment indicated on the patent would be corrected by the issuance of a certificate of correction showing a revised patent term adjustment of 210 days. The Office issued the certificate of correction on August 25, 2009. On August 26, 2009, patentees mailed a "RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION."

Patentees request recalculation of the patent term adjustment. Patentees assert, pursuant to 37 CFR 1.703(f), the period of adjustment of the term of the patent under 37 CFR 1.702 is the sum of the periods of examination delay calculated under subparagraphs (a)-(e), to the extent that such periods are not overlapping, less the sum of the periods calculated under 37 CFR 1.704 (the period of applicant delay). Patentees contend no periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap. Therefore, patentees maintain that they are entitled to the sum of 322 (299 + 23) days of examination delay plus 380 days of Three Year Delay, reduced by 171 (19 + 61 + 89 + 2) days of applicant delay, for a total patent term adjustment of 531 days. However, in the alternative, patentees assert that in the event that the USPTO maintains its interpretation of 35 U.S.C. 154(b)(1)(B) and 35 USC 154(b)(2)(A), patentees are entitled to 232 days of patent term adjustment, including 23 days of patent term adjustment for the period in excess of four months between payment of the Issue Fee and the date of issuance of the patent.

OPINION

At the outset, the Office reiterates that the period of adjustment under 37 CFR 1.702(b) for failure by the Office to issue the patent within three years is 381 days, not 380 days as stated by patentees. Furthermore, it appears that patentees used the 380 days in calculating the requested patent term determination of 531 days, or in the alternative, 232 days.

Pursuant to 37 CFR 1.703(b), the period of adjustment of 381 day is calculated as the number of days in the period beginning on

the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a), October 24, 2006, and ending on the date the RCE was filed November 8, 2007.¹ "When a period is indicated (in 37 CFR 1.703 or 1.704) as 'beginning' on a particular day, that day is included in the period, in that such day is 'day one' of the period and not 'day zero.'" MPEP 2731. "For example, a period beginning on April 1 and ending on April 10 is ten (and not nine) days in length." Id.

As to patentees' interpretation of the period of overlap, the Office finds that it is inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*² and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent

¹ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b).

² Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C.

154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that

periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

It is noted, however, that delays resulting in the Office's failure to meet the time frames specified in 35 U.S.C. 154(b)(1)(A) (the "fourteen-four-four-four" provisions) are not always overlapping with a delay resulting in the Office's failure to issue a patent within the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) because not all application pendency time is counted toward this three-year period. See 35 U.S.C. 154(b)(1)(B)(i)-(iii).

In this instance, all application pendency time is not counted toward the three-year period. A request for continued examination was filed on November 8, 2007. The period subsequent to the filing of the RCE is not included in the three-year time frame specified in 35 U.S.C. 154(b)(1)(B). See 35 U.S.C. 154(b)(1)(B)(i). Thus, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period from October 23, 2003 to November 8, 2007. Thus, only the 299 days³ of patent term adjustment accorded prior to the filing of the RCE pursuant to 37 CFR 1.702(a)(1)⁴ is considered in determining overlap. (The 23 days⁵ for Office delay under 37 CFR

³ The Office mailed a Restriction Requirement on October 18, 2005, 14 months and 299 days after the filing of the application on October 23, 2003.

⁴ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

⁵ The Office issued the patent on May 12, 2009, 4 months and 23 days after the payment of the issue fee on December 19, 2008.

1.702(a)(4),⁶ occurring subsequent to the filing of the RCE is not considered.) The 381 days of Office delay accrued as of the filing of the RCE under 37 CFR 1.702(b) is determined to overlap with the 299 days attributed to examination delay pursuant to 1.702(a)(1). Accordingly, at issuance, the Office entered 82 additional days of patent term adjustment for the Office taking in excess of three year to issue the patent.

In view thereof, the revised determination of patent term adjustment at the time of the issuance of the patent is 233 days (404 days (299 + 23 + 82) of Office delay - 171 days of applicant delay).

The Office acknowledges the previous payment of the \$200.00 fee under 37 CFR 1.18(e). No additional fees are required.

This matter is being forwarded to the Certificates of Correction Branch. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 233 days.

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

⁶ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

. . . .

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,531,174 B2

DATED : May 12, 2009

INVENTOR(S) : Sanicola-Nadel et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (210) days

Delete the phrase "by 210 days" and insert – by 233 days--